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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,150	10/31/2003	Easwaran Nambudiri	F-676	9842

919 7590 03/13/2008

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ART UNIT	PAPER NUMBER
3628	

MAIL DATE	DELIVERY MODE
03/13/2008	PAPER

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/698,150
Filing Date: October 31, 2003
Appellant(s): NAMBUDIRI, EASWARAN

Brian A. Lemm
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11 February 2008 appealing from the Office action mailed 13 November 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,361,164	SANSONE	03-2002
2005/0101143 A1	MONTGOMERY ET AL.	05-2003
6,860,425 B2	BRILEY ET AL.	03-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims **13** and**15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sansone, U.S. Patent No. 6,361,164 B1 in view of Montgomery et al., US2003/0101143 A1 and Briley et al., U.S. Patent No. 6,860,425 B2, hereinafter referred to as Sansone, Montgomery and Briley.

As per **Claims 13 and 15**, Sansone discloses a method and system that compares indicia printed on the mail piece with indicia stored in memory, comprising:

- transporting mail pieces along a transport path (C. 4, lines 52-54, also see Figure 4);
- printing a postage indicia on at least some of the mail pieces transported along the transport path, the postage indicia including a barcode and human-readable numerals that represent a postage amount (C. 4, lines 52-54, C. 8, line 66 – C. 9, line 6, also see Figure 9);
- receiving data from a postage security device (C. 6, lines 26-31).

Sansone fails to *explicitly* disclose reading the barcode and the human-readable numerals by using a reader mounted on the mailing machine. However, Sansone discloses a comparator that reads the printed material on a mail piece by reading the printer firings (that represent the alphanumeric characters or other data produced) and comparing it with the value stored in non-volatile memory (C. 2, lines 31-44). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Sansone and include reading postage indicia from a mailpiece, because it allows the system to validate the authenticity of the mail piece.

Furthermore, Montgomery teaches a scanning station that reads the self-validating postage indicium (two-dimensional barcode) on the mailpiece (0134). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Sansone and include reading the barcode of the mail piece as taught by Montgomery, because it allows the system to determine whether the mail piece is fraudulent or authentic.

Sansone fails to disclose comparing a postage amount represented by data read from the barcode with the postage amount represented by the human-readable numerals. However, Sansone discloses comparing postage indicia to indicia stored in the register of the postage meter (C. 2, lines 31-44, C. 6, lines 26-31). Moreover, Montgomery teaches validating mail piece postage by comparing barcode data to human-readable information (0134). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Sansone and include comparing a variety of postage indicia to

determine whether they match or not as taught by Montgomery, because it allows the system to determine whether the mail piece is fraudulent or authentic.

Sansone fails to disclose halting the transporting of mail pieces in response to the postage amount represented by data read from the barcode not matching with the postage amount represented by the human-readable numerals. However, Sansone disclose the system taking account of the comparison when a mismatch occurs and resetting the system (C. 5, lines 58-62, C. 6, lines 26-37). Further, Briley teaches halting operation of the system when the sensor determines that no postage indicia was printed on the media by the print head, where the control device controls operation of postage meter device in accordance with the results of the sensor determination (C. 1, line 54 – C. 2, line5, C. 2, lines 48-50). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Sansone and Montgomery and include stopping the operation of the system when a mismatch occurs as taught by Briley, because it allows the system user to correct the mismatch and determine if the mail piece is of a fraudulent nature.

(10) Response to Argument

First Issue

Applicant argues that the Examiner's rejection fails to meet the threshold burden of presenting a prima *facie* case of unpatentability. Examiner first notes that the cited references are analogous art. For instance, Sansone discloses a system for auditing the amount of postage that is being printed by comparing the value stored in the buffer with the value stored in the meter register (Abstract, C. 6, lines 26-31). Further, Montgomery et al. teaches a system for

detecting postage fraud (i.e. auditing the amount of postage that is being printed) using a unique mailpiece indicium. The Montgomery system compares the two-dimensional barcode with the human-readable information (0134). Moreover, Briley teaches a postage meter indicia verification system which halts the operation of the system when postage has not been printed on the media (C. 2, lines 1-3). Thus, the cited references are concerned with auditing the postage that is printed on the media. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Sansone discloses the mechanical elements of the claimed system, while the Montgomery system teaches comparing the human-readable portion to a barcode. Further, Sansone discloses halting the operation of the system when the comparison of values does not match (C. 7, lines 19-27), while Briley teaches halting the operation of the system when postage has not been found on the media (C. 2, lines 3). Therefore, a prima *facie* case of obviousness has been established.

Further, simple substitution of one known element for another to obtain predictable results renders a claim obvious. Sansone discloses the transport means and the printing means. Montgomery teaches comparing human-readable information with the barcode information on a mail piece. Further, Briley teaches halting the operation of a system when the sensor detects the lack of postage. Since each individual element and its function are shown in the prior art, albeit

shown in separate references, the differences between the claim subject matter and the prior art rests not on any individual element or function but in the very combination itself - that is in the substitution of the method of comparing of the Montgomery reference for comparator in the Sansone reference. Thus, the simple substitution of one known element for another producing a predictable result renders the claim obvious.

Second Issue

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant argues that the system of Sansone does not read the barcode and the human-readable numerals that have been already printed on the mail piece...The system in Sansone does not perform any type of scanning or reading of the postage indicium already printed on a mail piece. However, Examiner notes that Montgomery is cited for teaching this reference in the rejection. Sansone is cited for teaching, transporting mail pieces along a transport path (C. 4, lines 52-54, also see Figure 4); printing a postage indicia on at least some of the mail pieces transported along the transport path, the postage indicia including a barcode and human-readable numerals that represent a postage amount (C. 4, lines 52-54, C. 8, line 66 –C. 9, line 6, also see Figure 9); receiving data from a postage security device (C. 6, lines 26-31).

In the rejection, Sansone fails to *explicitly* disclose reading the barcode and the human-readable numerals by using a reader mounted on the mailing machine. Sansone does disclose a

comparator that reads the printed material on a mail piece by reading the printer firings, which represent the alphanumeric characters or other data produced (C. 2, lines 31-44). Thus, Sansone discloses reading alphanumeric data from a mail piece. Further, Montgomery teaches a stand-alone system that would be verifiable using only the human-readable information on the mail piece and the data encoded in the two-dimensional barcode of the postage indicium (0005). Furthermore, Montgomery teaches a scanning station that reads the self-validating postage indicium (two-dimensional barcode) on the mail piece and comparing it to the human-readable information read from the mail piece (0134, 0152). Thus, the combination of Sansone and Montgomery teaches reading alphanumeric and barcode information from a mail piece.

Montgomery is also cited for teaching the limitation of, comparing a postage amount represented by data read from the barcode with the postage amount represented by the human-readable numerals. Montgomery teaches validating mail piece postage by comparing barcode data to human-readable information (0134). Applicant argues that the validating performed in Montgomery is performed by the validation computer system which is not part of the postage indicia generation system. However, the end user computer, the central computer system and the postage validation computer system in Montgomery are all connected through the communications links (Figures 16-18). Further, Sansone discloses when one wants to print indicia on a mail piece one places mail piece in the mail piece transport…Controller will cause mail piece transport to move mail piece…Controller will transmit the position data for region of indicia to droplet image value capture processor (C. 4, line 26 – C. 5, line 16). Thus, Sansone also discloses a validation system coupled to the indicia generation system. Further, if a new combination of old elements is to be patentable, the elements must cooperate in such manner as

to produce a new, unobvious, and unexpected result. It must amount to an invention. In re Venner, 120 USPQ 192 (CCPA 1958), In re Smith, 73 USPQ 394.

Applicant argues Briley does not disclose a mailing machine that includes any type of reading means, located adjacent the transport path, for reading the barcode and the human-readable numerals or comparing means coupled to the reading means for comparing a postage amount represented by data read from the barcode with the postage amount represented by the human-readable numerals. However, the combination of Sansone and Montgomery was cited for teaching the above limitation. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Briley was cited for a control device configured to stop the postage meter device based on a determination (C. 1, line 54 - C. 2, line 5, C. 2, lines 48-50). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Sansone and Montgomery and include a control device to stop the postage meter system based on a determination.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Fadey S Jabr/
Examiner, Art Unit 3628

/John W Hayes/
Supervisory Patent Examiner, Art Unit 3628

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